



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,379	05/11/2001	Paul M. Lizardi	25006.0005U3	7125

23859 7590 09/15/2003

NEEDLE & ROSENBERG, P.C.
SUITE 1000
999 PEACHTREE STREET
ATLANTA, GA 30309-3915

EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
----------	--------------

1634

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/853,379

Applicant(s)

LIZARDI, PAUL M.

Examiner

Frank W Lu

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/27/2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-45 and 53-171 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 42-45 and 53-171 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

Art Unit: 1634

DETAILED ACTION

Location of Application

1. The Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1634.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 42-45 and 162-171, drawn to an in vitro method of cloning nucleic acid molecules, classified in class 435, subclass 91.2
 - II. Claims 53-61, drawn to an in vitro method of cloning nucleic acid molecules, classified in class 435, subclass 91.2.
 - III. Claims 62-69, drawn to a method of isolating and amplifying nucleic acid molecules, classified in class 435, subclass 91.2.
 - IV. Claims 70-72 and 74-76, drawn to a kit for isolating and amplifying nucleic acid molecules, classified in class 435, subclass 810.
 - V. Claims 73 and 77, drawn to a kit of isolating and amplifying nucleic acid molecules, classified in class 435, subclass 810.
 - VI. Claims 78-161 drawn to a method of isolating and amplifying nucleic acid molecules, classified in class 435, subclass 91.2.
3. The inventions are distinct, each from the other because of the following reasons:

Art Unit: 1634

Groups I and II are distinct or/and independent inventions in that they are directed to methods which comprise different method steps. As a result, different or/and distinct searches will have to be performed. For example, the search required for Group II such as step (e) of claim 53 is not required for Group I.

Groups I and III are distinct or/and independent inventions in that they are directed to methods which comprise different method steps. As a result, different or/and distinct searches will have to be performed. For example, the search required for Group III such as step (c) of claim 62 is not required for Group I.

Group I and Groups IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products as claimed can be used in a materially different process of using that products such as the method in Group II.

Groups I and VI are distinct or/and independent inventions in that they are directed to methods which comprise different method steps. As a result, different or/and distinct searches will have to be performed. For example, the search required for Group I such as step (e) of claim 42 is not required for Groups VI.

Groups II and III are distinct or/and independent inventions in that they are directed to methods which comprise different method steps. As a result, different or/and distinct searches will

Art Unit: 1634

have to be performed. For example, the search required for Group III such as step (c) of claim 62 is not required for Group II.

Group II and Groups IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products as claimed can be used in a materially different process of using that products such as the method in Group I.

Groups II and VI are distinct or/and independent inventions in that they are directed to methods which comprise different method steps. As a result, different or/and distinct searches will have to be performed. For example, the search required for Group II such as step (e) of claim 53 is not required for Group VI.

Group III and Groups IV and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products as claimed can be used in a materially different process of using that products such as the method in Group I.

Groups III and VI are distinct or/and independent inventions in that they are directed to methods which comprise different method steps. As a result, different or/and distinct searches will

Art Unit: 1634

have to be performed. For example, the search required for Group III such as step (c) of claim 62 is not required for Group VI.

Groups IV and V are distinct or/and independent inventions in that they are directed to different products. As a result, different or/and distinct searches will have to be performed. For example, the search required for Group V such as overlap in a linear vector of claim 73 is not required for Group IV.

Groups IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products as claimed can be used in a materially different process of using that products such as the method in Group I.

Groups V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the products as claimed can be used in a materially different process of using that products such as the method in Group I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1634

4. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (703) 308-1119.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.



Frank Lu
September 5, 2003